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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,385	07/27/2001	Karl-Heinz Schwonke	D078 1130.1	7824
7590 06/23/2006 Womble Carlyle Sandridge & Rice, PLLC P.O. Box 7037 Atlanta, GA 30357-0037			EXAMINER AHMED, SHEEBA	
			ART UNIT 1773	PAPER NUMBER

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/916,385	SCHWONKE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sheeba Ahmed	1773	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19,20,22-31,37-41,43-58 and 74-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 77 is/are allowed.
- 6) ☒ Claim(s) 19,20,22-31,37-41,43-58,74-76, 78, and 79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/18/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 18, 2006 has been entered.

### ***Response to Amendment***

2. Amendments to claims 19, 22-27, 37-39, 43-53, 58, and 76 have been entered in the above-identified application. New claims 78 and 79 have been added. **Claims 19, 20, 22-31, 37-41, 43-58, and 74-79 are pending and under consideration.**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 19, 20, 22-31, 37-41, 43-58, and 74-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 19, 37, and 76 have been amended to recite that the "flakes are oriented substantially parallel to the surface of the linoleum sheet". The phrase

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"substantially parallel" is a relative phrase which renders the claim indefinite. The phrase "substantially parallel" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 19 recites that the flakes have "a particle size in the range of 0.5 to 30mm and a thickness in the range of 1.0 to 400 microns". However, it is unclear what is meant by "particle size" in this instance. The claim recites a flake and Figure 3 shows flakes of irregular shapes hence a particle size would not be the proper terminology to describe the length and width of the flakes. Similar ambiguity exist in claims 37-41, 74, and 76.

Claims 47 and 78 recite improper Markush groups.

Appropriate correction or clarification is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 19, 20, 22-31, 37-41, 43- 58, 74, 75, 78, and 79 are rejected under 35 U.S.C. 102(b) as being anticipated by Dobry et al. (US 2,962,081).

Dobry et al. disclose plastic composition sheets that are adapted for use as floor coverings wherein the process of making such a plastic composition sheet entails

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depositing uniformly on a backing material a smooth layer of a mixture of fine particles and flat plastic chips (Column 1, lines 49-65). The plastic chips are about 0.18 to 1.0 inches in diameter (equivalent to 4.57 to 25.40 mm) and have a thickness of 0.01 to 0.025 inches (equivalent to 254-635 microns) (Column 2, lines 37-45). The process of the disclosed invention is applicable to various types of plastic compositions used in surface coverings including linoleum (Column 2, lines 71-72). If the plastic composition is linoleum then the linoleum is composed of drying oils, resin, fillers and pigments. The oil can be linseed oil. The resin can be rosin or ester gum. The thickness of the plastic layer can be varied and is typically 0.02 to 0.06 inches in thickness (Column 6, lines 11-31, 70-75). Typical of other suitable resins are polymethyl methacrylates (Column 5, lines 27-30). Figure 2 is a cross-sectional view of the surface covering and specifically shows that the plastic chips (10) are imbedded in the matrix of fine granules (11) and wherein a backing material (20) is also present. Claims 78 and 79 recite that the polymeric material may be selected from the recited Markush groups and Dobry et al. meet the limitation that the polymeric material may be a polymethyl methacrylate. Claims 22-27 and 43-53 are dependent on claims 78 and 79, respectively, and do not positively recite that the polymeric material is a reaction product of a carboxylic acid and an epoxidation product of a carboxylic acid ester and hence claims 22-27 and 43-53 are rejected under Dobry et al. All limitations of claims 19, 20, 22-31, 37-41, 43- 58, 74, 75, 78, and 79 are disclosed in the above-recited reference.

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5. Claims 19, 20, 22-31, 37-41, 43- 58, 74, 75, 78, and 79 rejected under 35 U.S.C. 102(b) as being anticipated by Harris (US 3,325,337).

Harris discloses a resilient linoleum surface covering have inlaid design elements in which particles of accent material are visible interiorly of the design elements (Column 1, lines 10-15). The molded linoleum surface coverings have inlaid, novel design effects which are achieved by using mottle of special composition. The mottle comprises particles of clear or transparent vinyl resin mix which is compatible with linoleum and particles of a linoleum binder (Column 2, lines 5-10). The particles of clear thermoplastic vinyl are particles of hydrolyzed vinyl chloride-vinyl acetate copolymer (Column 2, lines 35-70). The particles of linoleum binder and vinyl resin have an average particle size of less than the thickness of the designs elements (Column 3, lines 4-10). Examples 1 shows that the particle of both the linoleum binder and the vinyl particles may be 0.07 inches. Claims 78 and 79 recite that the polymeric material may be selected from the recited Markush groups and Dobry et al. meet the limitation that the polymeric material may be a polymethyl methacrylate. Claims 22-27 and 43-53 are dependent on claims 78 and 79, respectively, and do not positively recite that the polymeric material is a reaction product of a carboxylic acid and an epoxidation product of a carboxylic acid ester and hence claims 22-27 and 43-53 are rejected under Dobry et al. All limitations of claims 19, 20, 22-31, 37-41, 43- 58, 74, 75, 78, and 79 are disclosed in the above-recited reference.

***Response to Arguments***

6. Applicant's arguments filed on May 18, 2006 have been fully considered but are not persuasive. Applicants traverse the 35 U.S.C. 102(b) rejection based on Dobry et al. (US 2,962,081) and submit that Dobry et al. fail to teach or suggest a planar structure comprising a linoleum sheet containing flakes over its whole cross-section or entire cross-section given that the bulk flake material is spread through a stencil and then compressed to give a distribution of chips only on the surface stratum of the floor covering. Applicants further submit that the plastic chips can not be distributed throughout the entire thickness of the sheet. However, the Examiner disagrees. Dobry et al. disclose plastic composition sheets that are adapted for use as floor coverings and comprise a backing material and a smooth layer of a mixture of fine particles and flat plastic chips (Column 1, lines 49-65). The plastic chips are about 0.18 to 1.0 inches in diameter (equivalent to 4.57 to 25.40 mm) and have a thickness of 0.01 to 0.025 inches (equivalent to 254-635 microns) (Column 2, lines 37-45). The thickness of the plastic layer, which is linoleum, can be varied and is typically 0.02 to 0.06 inches in thickness (Column 6, lines 11-31, 70-75). Furthermore, Figure 2 is a cross-sectional view of the surface covering and specifically shows that the plastic chips (10) are imbedded in the matrix of fine granules (11) and hence are present over the whole cross section of the plastic composition. Layer 20 is a backing material and does not form part of the sheet comprising the plastic chips and the matrix of fine granules. In other words, the layer comprising the plastic chips and matrix of fine granules meets the limitations of the claimed planar structure.

***Allowable Subject Matter***


7. Claim 77 is allowed.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Mondays-Thursdays from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sheeba Ahmed  
Art Unit 1773  
June 19, 2006